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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/267,489 03/11/99 WALKER

J WD2-98-092

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WM02/1108

EXAMINER

REAGAN, J

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/267,489

Applicant(s)

WALKER ET AL.

Examiner

James A. Reagan

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2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

SAN RIVER
PRIMARY EXAMINER
AJ266

Detailed Action

1. This action is in response to the application filed on 11 March 1999.
2. Claims 1-59 have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on 11 March 1999 (paper number 4) and the Supplemental Information Disclosure Statement filed on 21 June 1999 (paper number 5) have been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1, 5-12, 14, 18-21, 27, 31-39, and 43-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Druckenmiller et al., United States Patent Number 6,167,435, hereafter referred to as "Druckenmiller."

Claims 1, 27, 39, and 56:

Sending an automated verification email message to the mailing list member and receiving a response from the member (column 2, lines 10-19).

Selecting a mailing list from a plurality of mailing lists is inherent to the process of developing mailing lists according to a demographic, product, service, or other relevant subject (column 1, lines 14-15, column 3, lines 4-13 and lines 55-61).

The limitations of Claims 27, 39, and 56 are of the same scope as the limitations of Claim 1, and are therefore rejected on the same basis.

Claim 14:

The limitations of Claim 14 are of the same scope as the limitations of Claim 1, and are therefore rejected on the same basis, with the following noted exceptions. Claim 14 recites a processor, database, communication port, and a memory. Druckenmiller discloses a computer and a database in Figure 1.

Claim 51:

The limitations of Claim 51 are of the same scope as the limitations of Claim 1, and are therefore rejected on the same basis, with the following noted exceptions. Claim 51 recites creating a mailing list. Druckenmiller discloses creating a subscriber list in column 6, lines 14-16.

Claims 5, 18, 31, and 43:

An email message is sent to each member of the mailing list. The content of each email is individualized and differs from the others by the email address and token identifier tailored to each subscriber (column 3, lines 34-45 and Figure 3).

Claims 6, 19, 32, and 44:

Storing the data concerning the member, such as subscriber information from the subscription form (column 6, lines 42-50).

Claims 7, 20, 33, and 45:

Selected topics are imbedded into the email to determine the content of the mailing list the member is to be associated with (column 3, lines 55-61).

Claims 8, 35, 47, 54, and 58:

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

Claims 9, 36, 48, and 55, and 59:

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

Claims 10, 37, and 49:

Mailing list selection based on the answers to the demographic/topic of interest questions (column 6, lines 34-42).

Claims 11, 21, 34, 38, 46, 50, 52, and 57:

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In

addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

Claims 12:

Response to the message is made through a URL (column 2, lines 16-19).

Claim 53:

Subscription to a mailing list may be made through a telephonic connection (column 8, lines 54-56).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 15-17, 28-30, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of Applicant's own admission.

Claims 2, 15, 28, and 40:

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Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose selling the mailing lists. Applicant, however, on page 2, line 10 of the specification, discloses a business purchasing a mailing list, inherently disclosing that a mailing list is bought and sold as a marketable item. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then selling the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth.

Claims: 3, 16, 29, and 41:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 2, lines 8-9 of the specification, discloses that a mailing list may be rented. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then renting the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Renting is an option to purchasing the list because the accuracy of the list may decrease after a period of time, driving the value of the list downward.

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Claims 4, 17, 30, and 42:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claims 1, 14, 27, and 39. Druckenmiller does not disclose renting the mailing lists. Applicant, however, on page 1, line 29 to page 2, line 1 of the specification, discloses that a mailing list may be used to "mail promotional items such as brochures, advertisements, or sales offers to persons included in the list." It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then mailing items to members on the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization's customer/client base, thereby generating potential growth. Directly mailing brochures, advertisements, or sales offers promotes reasonable expansion by selectively targeting individual and groups who may be interested in involving themselves with the organization.

8. Claims 13 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller in view of McEvoy et al., United States Patent Number 6,292,785, hereafter referred to as "McEvoy."

Claims 13 and 26:

Shown above, Druckenmiller discloses the subscription verification method as disclosed in the rejections of Claim 1. Druckenmiller does not disclose compensating list members with an incentive. McEvoy, however, in

column 5, lines 13-27, discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and compensating members who join the list because a reliable and accurate list of customer leads is a valuable asset, and enticing members with an incentive is a proven and effective way to increase participation, thereby increasing the value of the mailing list.

Claim 22:

A test identifier i.e. token (column 5, lines 17-20), a member identifier i.e. email address (column 5, line 2), creating and retrieving the test record, and updating the record based on member response (column 5, lines 34-54).

Claim 23:

Questions in the form of topics of interest and the answers and other demographic data are submitted to the mailing list database (column 3, lines 4-13).

Claim 24:

Indicating the importance of a maximized response rate (column 8, lines 19-32). Inherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members. In addition, mailing lists with low response rates are considered less than ideal (column 1, lines 14-23), versus mailing lists with greater response rates, which

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are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40-41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.

Claim 25:

Response to the message is made through a URL (column 2, lines 16-19).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Reagan whose telephone number is 703.306.9131. The examiner can normally be reached on 8:00a - 5:00p M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Rimell can be reached on **(703) 306-5626**. The fax phone numbers for the organization where this application or proceeding is assigned are 703.746.7239 for regular communications and 703.746.7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

JAR
November 2, 2001

Sam Rimell
Primary Examiner
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